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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF

Inventor : Terry L. Oehrke
Serial No. : 09/594,070
Filing Date : June 14, 2000
Title : COMPUTER NETWORK METHOD AND SYSTEM
FOR GUARANTEED MESSAGING SERVICE

Group/Art Unit : 2144
Examiner : Michael A. Delgado

Docket No. : 1234

Mail Stop Appeal Brief – Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant submits this Reply
Brief in response to the Examiner's Answer mailed on June 19, 2006.

REMARKS

In the Examiner's Answer responding to Appellant's Supplemental Appeal Brief, the
Examiner maintains his rejection of Claims 1-4, 7-12 and 15-19 under 35 U.S.C. § 103(a) as
being unpatentable over U.S. Patent No. 6,438,583 to McDowell et al. ("McDowell") in view of
U.S. Patent No. 5,974,122 to Nelson et al. ("Nelson"). The Examiner also maintains his rejection
of Claims 5-6 and 13-14 under 35 U.S.C. § 103(a) as being unpatentable over McDowell and

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Nelson in view of U.S. Patent No. 6,182,224 to Doshi et al. ("Doshi"). Appellant provides the following remarks in response to the Examiner's Answer.

I. Claims 2, 3, 4, 6, 8, 10, 11, 12, 14, 16, 18 and 19

Appellant respectfully submits that a prima facie case of obviousness for rejecting Claims 2, 3, 4, 6, 8, 10, 11, 12, 14, 16, 18 and 19 has not been established in that McDowell and Nelson, alone or in combination, do not disclose or suggest the claimed invention. As the standard for assessing obviousness, MPEP § 706.02(j) lists three basic criteria for establishing a prima facie case of obviousness under 35 U.S.C. § 103:

- (1) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (2) Second, there must be a reasonable expectation of success.
- (3) Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Examiner has failed to meet at least two of these requirements, namely: (a) the Examiner has not identified a proper suggestion or motivation to combine McDowell and Nelson; and (b) McDowell and Nelson do not teach or suggest all the claim limitations. A finding that either requirement has not been met necessitates a reversal of the Examiner's rejection under 35 U.S.C. § 103(a).

A. McDowell and Nelson Do Not Disclose All of the Claim Limitations

Claims 2, 3, 4, 6 and 8 of the present application each recite a method for providing a messaging service on a computer network that includes the steps of: (a) routing a message to a messaging server; (b) providing the message to a relay server when the message is undeliverable to the messaging server; (c) re-routing the message from the relay server to the messaging server when operational; and (d) invoking another messaging server when the message is undeliverable

to the messaging server in step (c). As submitted in Appellant's Supplemental Brief, neither McDowell nor Nelson disclose or suggest invoking "another messaging server" when a message is undeliverable to a messaging server after the attempted re-routing of the message to the inoperational messaging server.

Similarly, Claims 10, 11, 12, 14, 16, 18 and 19 of the present application each recite a computer network for providing a messaging service that includes: a messaging server; a DNS server operable to route a message to the messaging server; a relay server operably connected to the DNS server and the messaging server, the DNS server operable to provide the message to the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server, wherein the relay server is operable to re-route the message from the relay server to the messaging server when operational; and another messaging server invoked or created when the messaging server is inoperable such that the message is undeliverable to the messaging server in response to re-routing. As submitted in Appellant's Supplemental Brief, neither McDowell nor Nelson disclose or suggest "another messaging server" that is invoked or created when the messaging server is inoperable such that the message is undeliverable to the messaging server in response to re-routing.

The Examiner's sole response is the following paragraph on page 9 of the Examiner's

Answer:

In response to the argument that the limitation of "another message server" is not taught by prior art. McDowell teaches about an Email that is undeliverable to an old ISP (message server) due to the fact that the recipient of the intended message no longer has an active account. A re-router server (relay server) is used to locate a new ISP (another messaging server) (Col 6, lines 50-65). This feature in light of the Nelson reference at the time of the invention would have been obvious to any one of ordinary skill in the art.

The Examiner attempts to equate the step of forwarding a message intended for an old ISP to a new ISP (as taught by McDowell) with the step of invoking or creating another messaging server when a message cannot be re-routed from a relay server to a messaging server when operational (as provided in the claimed invention). The forwarding step taught in McDowell occurs every time a message addressed to a previous subscriber is sent to the old ISP. Specifically, each incorrectly addressed e-mail message is sent to the old ISP where it is identified as a message for a previous subscriber and forwarded to the new ISP. By contrast, the claimed invention invokes or creates another messaging server only after the relay server has attempted to re-route the message to the messaging server and cannot do so because the messaging server is not operational.

The Examiner also mistakenly contends on page 10 of the Examiner's Answer that the limitation of "undeliverable" with respect to routing a message to the messaging server does not limit the claim to a non-operational state:

The limitation of "undeliverable" as claimed does not limit the claim to a non-operational state as argued by applicant. The claims being presented broadly include the case of McDowell in which a message is undeliverable due to the client no longer being a member of the ISP.

This is simply incorrect. Claims 2, 3, 4, 6 and 8 of the present application require that "another messaging server" is invoked when the message is undeliverable to the messaging server in step (c). Step (c) requires that a message be routed from the relay server to the messaging server when operational. Similarly, Claims 10, 11, 12, 14, 16, 18 and 19 of the present application require that "another messaging server" is invoked or created when the messaging server is inoperable (i.e., not operational) such that the message is undeliverable to the messaging server in response to re-routing. It appears that the Examiner has ignored these claim limitations in an effort to bolster his improper rejection under 35 U.S.C. § 103(a).

Because neither McDowell nor Nelson teach invoking or creating another messaging server when the messaging server is not operational such that the message cannot be re-routed from the relay server to the messaging server, Claims 2, 3, 4, 6, 8, 10, 11, 12, 14, 16, 18 and 19 are not obvious and are patentable over McDowell in view of Nelson. Accordingly, Appellant respectfully requests that the Examiner's rejection be reversed.

B. No Motivation to Combine McDowell and Nelson

In March 2006, the Federal Circuit further articulated the motivation-suggestion-teaching requirement and held:

[T]o establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. In practice, this requires that the Board “explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

By requiring the Board to explain the motivation, suggestion, or teaching as part of its prima facie case, the law guards against hindsight in all cases—whether or not the applicant offers evidence on secondary considerations—which advances Congress's goal of creating a more practical, uniform, and definite test for patentability.

In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006). When there is no explanation of the motivation, suggestion, or teaching to combine references, there is an inference that improper hindsight was used to conclude that the invention was obvious. Id.

The only motivation, suggestion, or teaching to combine McDowell and Nelson advanced by the Examiner is on pages 8 and 9 of the Examiner's Answer:

The common goal of both references is to ensure that a message is delivered to its rightful owner despite changes or failures in a network (See abstract for both prior arts).

Being that both references are directed to the same kind of problem and being analogous to the network art, the combination is valid.

However, the Examiner's statements that there is a common goal between the two references and that the two references are directed to the same kind of problem is incorrect.

McDowell solves the problem that occurs when an e-mail message is sent to an incorrect e-mail address associated with an old ISP when the subscriber has switched to a new ISP. The McDowell network itself remains operational regardless of the ISP subscription change. The goal in McDowell is to forward the e-mail message to the proper recipient despite the incorrect e-mail address. By contrast, Nelson solves the problem that occurs when a fax is sent to an unresponsive fax machine. In Nelson, the fax has been sent to the correct fax number and the problem is the result of the unresponsive fax machine. The goal in Nelson is to send the fax to the intended fax machine when the fax machine is responsive, or, to notify the sender that the fax was not successfully sent after a period of time. Thus, McDowell and Nelson are not directed to the same kind of problem and do not share a common goal.

Because the only motivation, suggestion, or teaching to combine McDowell and Nelson advanced by the Examiner is incorrect, the Examiner has failed to carry his burden of establishing a prima facie case of obviousness. Without a valid explanation of the motivation to combine these references, it must be inferred that the obviousness conclusion is based on improper hindsight. Simply put, Claims 2, 3, 4, 6, 8, 10, 11, 12, 14, 16, 18 and 19 are not obvious and are patentable over McDowell in view of Nelson. Accordingly, Appellant respectfully requests that the Examiner's rejection be reversed.

II. Claims 1, 5, 7, 9, 13, 15 and 17

Appellant respectfully submits that a prima facie case of obviousness for rejecting Claims 1, 5, 7, 9, 13, 15 and 17 has not been established in that the Examiner has not advanced a valid explanation of any motivation, suggestion, or teaching to combine McDowell and Nelson.

As discussed in section I.B above, to establish a prima facie case of obviousness, the Examiner is required to explain what motivation a person of ordinary skill in the art would have had to combine McDowell and Nelson. See Kahn, 441 F.3d at 986. In this case, the only motivation to combine McDowell and Nelson advanced by the Examiner is that the references share a common goal and are directed to the same kind of problem. As explained above, however, McDowell and Nelson do not share a common goal and are not directed to the same kind of problem. McDowell discloses a fully operational network that forwards an incorrectly addressed e-mail message from an old ISP to a new ISP. By contrast, Nelson discloses the attempted delivery of a fax to an unresponsive fax machine. Without the "common goal" or "directed to the same kind of problem" motivation, the Examiner advances no explanation as to why a person of ordinary skill in the art would have been motivated to combine these references. Thus, there is an inference that the Examiner used improper hindsight to conclude that the invention was obvious.

Because the only motivation, suggestion, or teaching to combine McDowell and Nelson advanced by the Examiner is incorrect, the Examiner has failed to carry his burden of establishing a prima facie case of obviousness. Without a valid explanation of the motivation to combine these references, it must be inferred that the obviousness conclusion is based on improper hindsight. Simply put, Claims 1, 5, 7, 9, 13, 15 and 17 are not obvious and are patentable over McDowell in view of Nelson. Accordingly, Appellant respectfully requests that the Examiner's rejection be reversed.

III. Claims 5, 6, 13 and 14

The Examiner's rejection of Claims 5, 6, 13 and 14 as being obvious over McDowell in view of Nelson, in further view of Doshi, is improper. Claims 5, 6, 13 and 14 depend from and

incorporate all of the limitations of Claims 1 and 9, respectively. For at least the reasons explained above, Claims 1 and 9 are not obvious over McDowell in view of Nelson and, thus, dependent Claims 5, 6, 13 and 14 are also not obvious regardless of the additional Doshi reference. See In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); see also MPEP § 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious."). Thus, Appellant respectfully requests that the Examiner's rejection be reversed.

For the foregoing reasons, Appellant respectfully submits that Claims 1-19 are patentable over McDowell, Nelson and/or Doshi and should be allowed. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejections and allow Claims 1-19.

Respectfully submitted,

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